

Appl. No. 10/034,816
Amdt. dated April 21, 2004
Reply to Office Action of January 21, 2004

Remarks

Claims 1 - 10 are pending in the instant application. Claims 11 - 20 have been canceled; however, Applicants reserve the right to seek patent protection for non-elected subject matter by divisional application.

In the Office Action mailed January 21, 2004 the Examiner rejects Claims 1 - 10 under 35 U.S.C. §§ 102 and 103. Based on the amendments and remarks made herein, Applicants respectfully request that the rejections be withdrawn and that the application be passed to allowance.

1. Information Disclosure Statements

The Examiner's attention is drawn to the Supplemental Information Disclosure Statement that was mailed on September 17, 2003. The Examiner is requested to make of record receipt and review of the documents listed therein.

2. Response to Paragraphs 1 of the Office Action mailed January 21, 2004

Applicants hereby affirm the provisional election made on September 8, 2003, of Claims 1 - 10. Applicants reserve the right to seek patent protection for the subject matter of canceled Claims 11 - 20 by divisional application.

3. Rejection under 35 U.S.C. §102(b) (Paragraphs 2 - 3 of the Office Action mailed January 21, 2004)

In the Office Action mailed January 21, 2004, the Examiner rejects Claims 1 - 5, 9 and 10 under 35 U.S.C. § 102(b) as allegedly being anticipated and therefore unpatentable over U.S. Patent No. 5,948,707 issued September 7, 1999 to Crawley et al. (hereinafter "the Crawley patent"). Applicants respectfully traverse the rejection.

In order to be anticipatory, a reference must explicitly or implicitly disclose each and every element of the claimed invention. Claim 1 of the present invention is directed to an absorbent article including a vapor-permeable liquid-impermeable bottomsheet having an interior surface and an exterior surface; an absorbent structure positioned adjacent the interior surface; and a non-adhesive skid-resistant coating applied to the exterior surface such that the bottomsheet remains vapor-permeable after application of the coating. The Crawley patent relates to a non-slip, waterproof, water vapor permeable fabric material. (See Col. 1, lines 6-7).

Appl. No. 10/034,816
Amdt. dated April 21, 2004
Reply to Office Action of January 21, 2004

The Crawley patent does not disclose (either explicitly or implicitly) each and every element of the invention of independent Claim 1. For example, the Crawley patent does not disclose an absorbent article including an absorbent structure. Instead, the Crawley patent discloses a fabric having an inner layer of a film or membrane with a suitable adhesive applied over its unexposed surface; adhesive joins a surface of the inner film layer to an inner surface of a layer of fabric, the fabric layer is preferably a stretch fabric of the type of fabric known as spandex. (See Col.6, lines 7 – 11 and 47 – 48). For at least this reason, Applicants respectfully submit that independent Claim 1 is patentable over the Crawley patent. Moreover, Claims 2 - 10, which depend from the above independent claim, are also accordingly patentable over the Crawley patent.

Further, Claim 2 of the present invention includes the elements of Claim 1 and also recites a liquid permeable topsheet having a first surface positioned adjacent the absorbent structure, sandwiching the absorbent structure between the topsheet and the bottomsheets. The Crawley patent does not disclose (either explicitly or implicitly) the additional elements of the invention of Claim 2. For example, the Crawley patent does not disclose an article including a liquid permeable topsheet. Instead, the Crawley patent describes "a waterproof, water vapor permeable fabric material which has non-slip properties." (Col. 3, lines 37 – 38). For at least this additional reason, Applicants respectfully submit that dependent Claim 2 is patentable over the Crawley patent. Based on the foregoing, Applicants respectfully request that the rejection under 35 U.S.C. §102(e) be withdrawn.

4. Rejection Under 35 U.S.C. § 103(a) (Paragraphs 2 - 3 of the Office Action mailed January 21, 2004)

In the Office Action mailed January 21, 2004, the Examiner rejects claims 6 - 8 under 35 U.S.C. § 103(a) as being unpatentable over the Crawley patent. Applicants respectfully traverse the rejection.

Claim 6 of the present invention includes the elements of Claim 1 and further recites that the absorbent article has a drape stiffness less than about 10 cm after application of the coating. Similarly, Claim 8 of the present invention includes the elements of Claim 1 and further recites that the absorbent article has a thickness less than about 15 mm. The Examiner acknowledges that the Crawley patent fails to disclose the dimensions or physical limitations required of Claims 6 and 8. The Examiner believes that the general conditions of the claims are met and that merely changing the size and/or shape of the article is well within the purview of one skilled in the art. Further, the Examiner believes that with regard to the limitation of drape stiffness (of Claim 6), the Crawley patent "teach[es] the use of the same chemical and structural requirement set forth by

Appl. No. 10/034,816
Amdt. dated April 21, 2004
Reply to Office Action of January 21, 2004

Applicant and thus it would be reasonable to presume that the property limitations of drape stiffness would inherently if not obviate the physical properties of the present invention" [emphasis added].

In order to establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143.

A *prima facie* case of obviousness has not been made; the Crawley patent does not teach or suggest all the claim limitations. As described above, the Crawley patent does not disclose an absorbent article including an absorbent structure. Instead, the Crawley patent describes "a waterproof, water vapor permeable fabric material which has non-slip properties." (Col. 3, lines 37 – 38). Further, there is no suggestion to modify the fabric of the Crawley patent to arrive at the absorbent article of the present invention. For example, the Crawley patent at Col. 4, line 66 – Col. 5, line 2 states, "[t]he inventive material is useful for any application where the waterproof and breathable qualities are desired and there is a need for reduced slippage when the material is in contact with human skin, another fabric or any other surface." At least this above passage teaches away from the claimed invention. Instead, the Crawley patent teaches a fabric that is waterproof and repels liquid, as opposed to a fabric that includes an absorbent structure that absorbs liquid, which is an aspect of Applicants' invention. The ability to absorb liquid is contrary to the teachings of the Crawley patent. Therefore, Applicants respectfully assert that the Crawley patent does not render claims 6 – 8 obvious.

Further, it appears that the Examiner is making an inherency argument. MPEP 2112.01 states that "[w]here the claimed and prior art products are identical or substantially identical in structure ... a *prima facie* cases of either anticipation or obviousness has been established" (emphasis added). As stated above, the Crawley patent does not disclose an absorbent article including an absorbent structure, therefore the claimed structure and the prior art structure are not identical or substantially identical in structure. Thus, the premise on which the inherency argument is based is incorrect. Therefore, for at least these reasons, Applicants submit that Claims 6 – 8 are patentable over the Crawley patent, and respectfully request that the rejection under 35 U.S.C. §103(a) be withdrawn.

In conclusion, and in view of the remarks and confirmation of the election, reconsideration and withdrawal of the rejections of Claims 1 – 10 under 35 U.S.C. §§ 102 and 103 are respectfully

Appl. No. 10/034,816
Amdt. dated April 21, 2004
Reply to Office Action of January 21, 2004

requested. Moreover, it is respectfully submitted that all of the presently presented claims are in condition for allowance and such action is earnestly solicited. If the Examiner has any questions or if there are any remaining issues that can be handled by telephone, the Examiner is invited to contact the undersigned at (920) 721-4558.

The Commissioner is hereby authorized to charge any prosecutorial fees (or credit any overpayment) associated with this communication to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such extension is requested and should also be charged to our Deposit Account.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: 920-721-4558.

Respectfully submitted,

Earle H. Sherrod ET AL.

By: 

David J. Klann

Registration No.: 46,833

Attorney for Applicant(s)

CERTIFICATE OF FACSIMILE

I, Barbara D. Miller, hereby certify that on April 21, 2004, this document is being facsimile transmitted to the Commissioner for Patents, Alexandria, VA 22313-1450 to facsimile number 703-872-9306.

By: 

Barbara D. Miller